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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/541,740

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David Marks

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20350

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02/23/2009

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EXAMINER

BROWN, COURTNEY A

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

02/23/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/541,740	Applicant(s) MARKS, DAVID	
	Examiner COURTNEY BROWN	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/2/2006</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Status of Claims

Claims 1-26 are pending and are being examined for patentability.

Priority

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. This application is a 371 of PCT/GB04/05063 filed on December 12, 2004. Applicant claims benefit to United Kingdom Application 0327864.5 filed December 2, 2003.

Information Disclosure Statement

The Information Disclosure Statements (IDS) submitted on June 2, 2006 has been considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4-6, and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 4-6, and 11 do not provide exactly what the w/w% of component (i) is based on. As a result, the w/w % of component (i) has been rendered indefinite.

Art Unit: 1616

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bessette et al. (US Patent Application 2003/0194454 A1) in view of Zocchi et al. (US Patent 5985814).

Applicant's Invention

Applicant claims a pesticidal composition comprising (i) one or more essential oils selected from tagetes oil or a thymol containing essential oil, or a mixture thereof, or components thereof which have insect repellent or deterrent properties, wherein the total amount of such oil or component present does not exceed 10%w/w; (ii) an agriculturally acceptable carrier oil and (iii) an emulsifier.

***Determination of the scope and the content of the prior art
(MPEP 2141.01)***

Bessette et al. teach novel pesticidal compositions containing rosemary oil and/or wintergreen oil that can be used with conventional pesticides, including conventional plant essential oils such as thyme oil ([0013]). Bessette et al. teach that the term "wintergreen oil" (Oil of Gaultheria procumbens) denotes both extracted (by distillation of the leaves of Gaultheria fragrantissima Wall) and synthetic versions (e.g., methyl salicylate, compound which remediate symptoms of viral infection and reduces ethylene production of instant application) ([0029]). Bessette et al. teach that the aforementioned composition may also comprise rosemary oil and/or wintergreen oil in combination with diluents such as mineral oil or other essential oils ([0039]) wherein said mineral oil,

Art Unit: 1616

other essential oils (e.g., safflower oil, benzyl alcohol, citronellal, d-limonene, soybean oil, sesame oil, etc.), and water ([0068]) may serve as diluents or carriers ([0069]).

Bessete et al. teach the use various optimum ratios between and among the constituents of each proprietary blend of essential oils such as, the mixing ratio of rosemary oil to wintergreen oil is the ratio wherein rosemary oil and wintergreen oil show a synergistic effect, and usually is from 100:1 to 1:100 parts by weight, preferably within the range from 13:1 to 1:13 ([0040]). Bessette et al. teach that the aforementioned compositions can be used with conventional pesticides ([0041]). In a preferred embodiment, Bessette et al. teach a pesticidal composition comprising rosemary oil and wintergreen oil in an admixture with mineral oil, lecithin (emulsifier of instant application) and water wherein rosemary oil is present in an amount of about 5-10%, wintergreen oil is present in an amount of about 20-45%, and mineral oil present in an amount of about 20-45% ([0055]). In another embodiment, Bessette et al. teach a pesticidal composition comprising rosemary oil and wintergreen oil with a suitable carrier and optionally with a suitable surface active agent, with and without one or more additional essential oil compounds such as soybean and thymol ([0060]). In Example 2, paragraph 0085, Bessette et al. teach a formulation wherein 0.5% w/w lecithin (emulsifier) is used. In Table 1-9, Bessette et al. teach the application of said pesticidal composition at 2 quarts/acre (about 2 liters per hectare). Bessette et al. additionally teach a method of treating a locus where invertebrate pest control is desired using said pesticidal composition ([0014]).

***Ascertainment of the difference between the prior art and the claims
(MPEP 2141.02)***

The difference between the invention of the instant application and that of Bessette et al. is that the instant invention claims a pesticidal composition that contains no more than 1.5%-10% w/w of the essential oil component as opposed to 5-10%. For this reason, the teaching of Zocchi et al. is joined. Zocchi et al. teach the use of an essential oil at a concentration of 0.1 to 10.0 wt. % in an acaricidal carpet cleaning composition (column 4, line 11).

Finding of prima facie obviousness

Rationale and Motivation (MPEP 2142-2143)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of the two cited references to arrive at a pesticidal composition comprising (i) one or more essential oils selected from tagetes oil or a thymol containing essential oil, or a mixture thereof, or components thereof which have insect repellent or deterrent properties, wherein the total amount of such oil or component present does not exceed 10%w/w. Zocchi et al. teach that at a concentration of 0.4 to 8 wt %, essential oils exhibit acaricidal activity (column 6, lines 32-60). One would have been motivated to make this combination in order to receive the expected benefit of having a pesticidal composition that does not require a large amount of active which will result in lower production costs. Thus, in view of *In re Kerkhoven*, 205 USPQ 1069 (C.C.P.A. 1980), it is *prima facie* obvious to combine two

Art Unit: 1616

or more compositions each of which is taught by prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in prior art.

Therefore, the claimed invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made because every element of the invention has been fairly suggested by the cited reference.

None of the claims are allowed.

Conclusion

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR Only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electron Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Courtney Brown, whose telephone number is

Art Unit: 1616

571-270-3284. The examiner can normally be reached on Monday-Friday from 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Courtney A. Brown
Patent Examiner
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/Mina Haghighatian/
Primary Examiner, Art Unit 1616